

ESTTA Tracking number: **ESTTA657961**

Filing date: **02/25/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Addison Lee Limited
Granted to Date of previous extension	02/25/2015
Address	35-37 William Road London, NW1 3ER UNITED KINGDOM
Domestic Representative	Michael J. Leonard Fox Rothschild LLP 997 Lenox Drive, Bldg. 3 Lawrenceville, NJ 08648-2311 UNITED STATES ipdocket@foxrothschild.com, mleonard@foxrothschild.com

Applicant Information

Application No	86207631	Publication date	10/28/2014
Opposition Filing Date	02/25/2015	Opposition Period Ends	02/25/2015
Applicant	A-List LLC 142 Deer Court Drive Middletown, NY 10940 UNITED STATES		

Goods/Services Affected by Opposition


Class 039. First Use: 2014/02/00 First Use In Commerce: 2014/02/00
All goods and services in the class are opposed, namely: Chauffeur driven car hire services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4212568	Application Date	07/25/2011
Registration Date	09/25/2012	Foreign Priority Date	NONE
Word Mark	ADDISON LEE AL		

Design Mark	
Description of Mark	The mark consists of the letters "AL" between the words "ADDISON LEE" in a stylized format.
Goods/Services	Class 039. First use: First Use: 0 First Use In Commerce: 0 Delivery, transport and collection of goods, letters and documents by courier; courier services for messages and letters; transport and delivery of goods and passengers by motorcycle, car, taxi and other land vehicles; parcel delivery services; car and motorcycle hire services; chauffeur services; escorting of travellers; transportation of travellers; transportation services, namely, transportation and delivery by air and road; travel agency services, namely, making reservations for transportation; VIP transportation, travel and hospitality services; booking seats for travel; freight and transport brokerage services; car parking services; freight forwarding services; garage rental services, delivery and storage of goods; provision of guarded transport of valuables; newspaper delivery services; packaging and wrapping of goods; portage services; moving company services; rental of storage containers; rental of vehicle roof racks; rental of warehouses; travel and transport reservation services

Attachments	85379610#TMSN.png(bytes) AL and Design Notice of Opposition.pdf(123240 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/michael leonard/
Name	Michael J. Leonard
Date	02/25/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RE: U.S. Trademark Application Serial No. 86/207631
Published in the Official Gazette on 28 October 2014

ADDISON LEE LIMITED,)	
)	
Opposer,)	
)	Opposition No. _____
-v-)	
)	
A-LIST LLC,)	
)	
Applicant.)	
)	
_____)	

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 86/207631 filed 28 February 2014 by A-List LLC (“Applicant”), to register the mark AL and Design for services described as "Chauffeur driven car hire services” in International Class 39 (“Applicant’s Services”), which was published in the Official Gazette on 28 October 2014, Addison Lee Limited (“Opposer”) of London, the United Kingdom, believes it will be damaged by the registration of the AL and Design mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a New York Limited Liability Company having an address at 142 Deer Court Drive, Middletown, NY 10940. On 28 February 2014, Applicant filed Application Serial No. 86/207631 for the following mark:



for Applicant's Services based on Applicant's claim of use of the mark in commerce since February 2014.

2. Opposer, founded in London, England in 1975, is a leading provider of taxi, minicab and chauffeur driven business car services, as well as package delivery services. Opposer is now rendering its services in over 350 cities worldwide, including New York, NY.

3. Opposer is the owner of U.S. Registration No. 4212568 for the following mark:



covering services described as “delivery transport and collection of goods, letters and documents by courier; courier services for messages and letters; transport and delivery of goods and passengers by motorcycle, car, taxi and other land vehicles; parcel delivery services; car and motorcycle hire services; chauffeur services; escorting of travellers; transportation of travellers; transportation services, namely, transportation and delivery by air and road; travel agency

services, namely, making reservations for transportation; VIP transportation, travel and hospitality services; booking seats for travel; freight and transport brokerage services; car parking services; freight forwarding services; garage rental services, delivery and storage of goods; provision of guarded transport of valuables; newspaper delivery services; packaging and wrapping of goods; portage services; moving company services; rental of storage containers; rental of vehicle roof racks; rental of warehouses; travel and transport reservation services;” in International Class 39. The foregoing Registration is not limited by channels of trade or classes of purchasers. Opposer's Registration is valid and subsisting, and is *prima facie* evidence of the validity of the registered Mark set forth therein, the registration of the registered Mark set forth therein, and Opposer's exclusive right to use the registered Mark set forth therein in connection with the Services specified in the registration.

4. Opposer is currently using, has invested substantial resources in advertising and promoting its services, and has acquired substantial goodwill under the ADDISON LEE AL and Design trademark.

5. Opposer will rely upon ownership of its federal trademark registration for the ADDISON LEE AL Mark and, upon information and belief, the common law rights it has obtained through its use of the ADDISON LEE AL Mark in United States commerce.

6. Commencing prior to Applicant's filing date and any alleged date of first use that can be claimed by Applicant, the ADDISON LEE AL Mark has been registered in connection with identical transportation-related services including, but not limited, to those services described as “chauffer services; escorting of travellers; transportation of travellers; transportation services, namely, transportation and delivery by air and road.”

7. Since its initial use of the ADDISON LEE AL Mark, Opposer has made a substantial investment in advertising and promoting Opposer's Services under its ADDISON LEE AL Mark. Opposer's customers and the public in general know and recognize Opposer's ADDISON LEE AL Mark and associate the Mark with Opposer and/or Opposer's Services. Opposer has built extensive goodwill in connection with the rendering of services under its ADDISON LEE AL Mark.

8. In the United States and worldwide, consumers recognize the ADDISON LEE AL Mark as a sign of quality in connection with chauffeur driven car hire services.

9. Applicant's filing of Application Serial No. 86/207631 for AL and Design mark is without license, authorization or permission from Opposer.

10. Opposer has registered the ADDISON LEE AL Mark to identify its transportation-related services rendered to its customers.

11. Opposer uses the ADDISON LEE AL Mark to identify its transportation-related services rendered to its customers.

12. Applicant's AL and Design mark wholly incorporates the AL term and is likely, when used in connection with Applicant's Services, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

13. Upon information and belief, the 28 February 2014 filing date of Application Serial No. 86/207631 is subsequent to Opposer's date of first use in United States commerce of its ADDISON LEE AL Mark.

14. Upon information and belief, the 28 February 2014 date of first use in commerce recited in Application Serial No. 86/207631 is subsequent to Opposer's constructive date of first use in United States commerce of its ADDISON LEE AL Mark.

15. Applicant's 28 February 2014 filing date is subsequent to the 25 September 2012 registration date of Opposer's ADDISON LEE AL and Design Registration.

16. Opposer's Services and Applicant's Services are so closely related and overlapping that they are offered and rendered or are likely to be offered and rendered through the same channels of trade and purchased by the same class of purchasers.

17. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Services rendered and marketed under Applicant's AL and Design mark and misled into believing that such services are offered by, rendered by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

18. Opposer will be damaged by the registration of the AL and Design mark as set forth in Application Serial No. 86/207631, in that the mark, which fully incorporates the AL wording of Opposer's Mark, is confusingly similar in appearance, sound and commercial impression to Opposer's ADDISON LEE AL and Design Mark, thereby violating Opposer's rights to its Mark.

19. Registration of Applicant's AL and Design mark should not be granted as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its ADDISON LEE AL and Design.

WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 86/207631 be refused and that the registration of AL and Design as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

ADDISON LEE LIMITED

Date: 25 February 2015

By: /michael leonard./
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Attorneys for Opposer Addison Lee Limited

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 25th day of February 2015 by sending same via First Class Mail, postage prepaid, to:

Michael F. Sarney
Moritt Hock & Hamroff LLP
450 7th Ave., 15th Fl.
New York, NY 10123

By: /michael leonard/